

## EXAMINER'S ISSUE CHECKLIST

When passing an application to issue, each of the following items should be checked:

### 1. CLAIMS

- Single sentence, starting with a capital letter and ending with a period (beware of claims ending with chemical structure and no period).
- Claim text should not be missing or contain duplicate or additional text.
- Make sure that there is a complete claim listing, and that the status identifier for each claim is correct.
- Claim numbering:
  - If needed, Examiner should renumber both the independent and dependent claims, properly using Issue Classification form (IFW).
  - No two claims are numbered the same.
- Dependent claims:
  - No claim depends from the wrong claim or a higher-numbered claim, as renumbered. If claims are renumbered in other than the order presented by applicant, amend numbering by Examiner's amendment (no attorney authorization).
  - Dependent claims narrow the scope of the claim from which they depend.
  - No improper multiple dependent claims

### 2. SPECIFICATION

- Abstract:
  - Abstract is present, and gives an adequate and clear statement of the disclosed invention (M.P.E.P. 608.01(b)).
  - No more than 150 words.
  - Single paragraph -no legal phraseology such as "said" or "means".
- Continuing data is mentioned in first paragraph, including §371 data, if any, and agrees with the Continuing Data on Bibliographic Data Sheet. **NOTE:** If application data sheet (ADS) has been filed and contains continuity data, continuing data do NOT need to be mentioned in first paragraph; however, the Bibliographic Data Sheet (BDS) must agree with the most recent ADS- correct BDS if necessary.
- U.S. applications referred to by Attorney Docket Number should be changed to U.S. Application Numbers. (Examiner's amendment, no attorney authorization required.)

**SPECIFICATION, continued**

- Update status of referenced U.S. applications (e.g. "now abandoned", or "issued as US Patent No.:" (Examiner's amendment, no attorney authorization required.)
- Recheck for Brief Description of Drawings of each figure. Note that if figures have multiple parts (e.g. Fig. 1A, Fig. 1B, etc.) Each individual part must be referred to in the brief description of the drawings. (Examiner's amendment, no attorney authorization required.)
- Recheck Brief Summary & Description to see if in harmony with the claims. If not, require applicant to modify, using FP 1307 (M.P.E.P. 1302.01).
- No blanks or missing text (e.g. "Serial Number \_\_\_\_").
- No unclear or missing words because of HOLES at top of page or poor copy quality.
- No missing pages or page numbers, no duplicate pages, page numbers are consecutive.
- Examples, tables, etc. numbered/lettered consecutively.
- Text and tables/charts legible.
- No non-initialed alterations.
- Minor, obvious errors in spelling, grammar, punctuation corrected by Examiner (Examiner's amendment, no attorney authorization required).
- CD-ROM submissions (e.g. large tables, computer programs) are in compliance with M.P.E.P. 608.05.

**Biotech only:**

- Complies with sequence rules:
  - CRF (computer readable form) filed and approved by STIC or generated from parent (M.P.E.P. 2422.05)
  - Raw sequence listing entered in IFW (STIC printout).
  - Sequence listing in IFW (copy provided by applicant).
  - Sequence listing matches CRF.
- All requirements for Deposit of Biological Materials have been fulfilled (See M.P.E.P. 2411: 37 C.F.R. §1.809).

### 3. OATH OR DECLARATION

- Original, first and sole/joint inventor(s) clause.
- Contains “reviewed and understands” and “duty of disclosure” statements, CIP oath states duty to disclose intervening art.
- Names of applicants on bibliographic data sheet same as in oath/declaration, unless there has been a request under 37 C.F.R. §1.48 to delete one or more inventors, and that request has been granted.
- Full given name for each applicant (M.P.E.P. 605.04(b)).
- Signature, Address and Citizenship for each inventor. (Address may be found on Application Data Sheet, see M.P.E.P. 601.05).
- Any alterations initialed and dated.
- Foreign priority includes country, serial number and filing date (check against bibliographic data sheet). (May be found on Application Data Sheet, see M.P.E.P. 601.05).
- Continuing data, if any, should be mentioned in the first sentences of the specification or ADS (not the oath or declaration). Especially in cases where an oath or declaration from a prior application is used, the continuity data may differ, and no objection should be made to the inclusion or lack or inclusion of continuity data in the oath. Benefit under 35 U.S.C. §120 should only be given if the application is mentioned in the first sentences of the specification, or on the ADS. See M.P.E.P. 601.05.

### 4. APPLICATION DATA SHEET

- If more than one Application Data Sheet is present, only the most recent one is considered.
- If present, must be compared with Oath/Declaration. If any discrepancies, a notice of defective oath or declaration should be sent. (M.P.E.P. 601.05)

### 5. PTO/SB/08 (former PTO-1449): INFORMATION DISCLOSURE STATEMENT (M.P.E.P 609)

- U.S. Patents-identified by patent number, patent date (Month-Year), and patentees.
- Foreign published applications and patents-identified by document number, publication date (Month-Year) and country or office.
- Printed publications-identified by author (if any), title, publication date (Month-Year), volume and issue number (if known), and pages relied on.

**PTO/SB/08, con't.**

- Examiner should initial all citations considered.
- Examiner should draw a line through each citation not considered.
- For each US patent considered, Examiner should insert the relevant classification or draw a line in the space provided for classification information.
- Sign and date each page.

**6. PTO-892 NOTICE OF REFERENCES CITED (M.P.E.P 707.05)**

- If applicants have not filed an information disclosure statement, the Examiner must cite references using a PTO-892, and the references must be appropriately addressed in an office action or in the notice of allowability. References cited at the time of allowance should be scanned into e-DAN, but do not need to be sent to applicants.
- U.S. Patents-identified by patent number, patent date (Month-Year), and patentees. If class/subclass not provided, line through appropriate boxes.
- Foreign published applications and patents-identified by document number, publication date (Month-Year) and country or office. If classification not provided, line through appropriate boxes.
- Printed publications-identified by author (if any), title, publication date (Month-Year), volume and issue number (if known), and pages relied on.

**7. DRAWINGS**

- Figure selected for printing must be consistent with claim selected for printing, and must be referred to in the abstract. If no figure is to be printed, write "none" in the appropriate box on the Issue Classification Sheet (IFW form).
- Do not select a figure labeled as "prior art" for printing.
- If color photographs or drawings are present, check M.P.E.P. 608.02 for requirements.

**8. IFW SEARCH NOTES FORM:**

- Update and complete Searched Box, Search Notes Box and Interference Searched Box.
- Search Notes Box:
  - Parent files checked
  - Record consultations with other examiners, primaries, SPEs, SPREs and TQASs.
  - Database searches recorded, with "printout attached" indicated, or search strategy set forth; specific vendors and files listed (e.g. Dialog, files 5, 55).
  - Inventor/assignee search noted for possible double patenting issues.
- Interference Searched Box:
  - Lists both original class and subclass and all cross-referenced classes and subclasses.
  - Indicates interference search of claimed sequences (Biotech).
  - Search the broadest claims on EAST or WEST for all original and cross-referenced classes and subclasses. Make sure PG-PUB file is searched.
  - Provide copies of search results in case.

**9. IFW ISSUE CLASSIFICATION FORM:**

- Assistant Examiner and Primary Examiner spaces should be completed.
- Primary Examiner must SIGN above their typewritten name.
- Update FINAL classification
- Complete classification cross-references.
- Complete INTERNATIONAL CLASSIFICATION- available on PTO intranet.
- Print claim should be the most comprehensive independent claim that conveys the nature of the invention. If dependent claim is printed, independent claim from which it depends must also be printed.
- If only one claim is being allowed, write "the" in the "print claim" box instead of "1".
- If there is a Terminal Disclaimer print IFW terminal disclaimer sheet.
- Index of Claims no longer required upon allowance, issue classification form is sufficient.

**10. BIBLIOGRAPHIC DATA SHEET:**

- TITLE-should reflect claimed invention-Rewrite if necessary (Examiner's amendment, no attorney authorization required; print Bib Data Sheet, correct, initial and date- give to LIE to be entered into PALM/IFW).
- Check that continuing data agrees with first paragraph of specification or Application Data Sheet (ADS). If continuity data has been omitted, print Bibliographic Data Sheet, correct, and have corrected document scanned into IFW. Additionally, have your LIE correct the data in PALM.
- Recheck Foreign-PCT application with oath or declaration. If in error, print Bibliographic Data sheet and correct in black ink, have LIE correct in PALM (See M.P.E.P. 202.03).
- Foreign priority claim should be verified and acknowledged.
- Check to see if certified copy of priority document is present and acknowledged.

## 11. MISCELLANEOUS

- Ensure that all amendments were timely filed and the application is not abandoned (all necessary extensions of time have been purchased or authorized).
- All foreign patents and publications cited during the prosecution should be scanned into eDAN.
- Papers pertaining to computer searches, e.g. PTO-1041, computer generated search reports, computer generated logic statements, sequence searches should scanned into eDAN (be sure to remove interference search).
- Check to ensure the substance of all interviews is of record.
- In cases filed under 35 U.S.C. §371, a PCT form 903 is present in IFW authorizing the filing under 371 and stating the priority dates. A photocopy of the ribboned priority document must also be in IFW.
- Double check that the claims are statutory under 35 U.S.C. §101

## 12. ITEMS TO BE PLACED IN RED FOLDER

### LEFT SIDE OF FOLDER:

(Papers to be scanned but not mailed)

- PTO-1472 Case Action Worksheet (Count Sheet)
- Issue Classification form (IFW)
- IFW-Application Number
- IFW-Search Notes including Interference search in PG-PUBs
- IFW-Terminal Disclaimer, if applicable
- Initial and update Bibliographic Data Sheet

### RIGHT SIDE OF FOLDER:

(Papers to be mailed to applicant)

- PTO-37 Notice of Allowability
- Examiner's Amendment (if applicable)
- Reasons for Allowance (if applicable)
- PTO-892 and/or PTO-1449 (if applicable)
- Any newly cited NPL or Foreign Patent or publication cited on PTO-892